



12-28-05

RW #

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/719,795-Conf. #2945
	Filing Date	November 21, 2003
	First Named Inventor	Robert R. Wood
	Art Unit	1712
	Examiner Name	C. R. Richard
Total Number of Pages in This Submission	Attorney Docket Number	HO-P02901US1

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input checked="" type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input checked="" type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Receipt Postcard Check in the amount of \$130.00 Statement Under 37 CFR 3.73(b) Copy of Office Action Certificate of Mailing
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	FULBRIGHT & JAWORSKI L.L.P.		
Signature			
Printed name	John E. Schneider		
Date	December 27, 2005	Reg. No.	31,998



Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL**
For FY 2005☒ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 130.00**Complete if Known**

Application Number	10/719,795-Conf. #2945
Filing Date	November 21, 2003
First Named Inventor	Robert R. Wood
Examiner Name	C. R. Richard
Art Unit	1712
Attorney Docket No.	HO-P02901US1

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____
☐ Deposit Account Deposit Account Number: 06-2375 Deposit Account Name: Fulbright & Jaworski L.L.P.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
☒ Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims
20	- 20 =	x	=	Fee (\$)

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
3	- 3 =	x	=

3. APPLICATION SIZE FEE

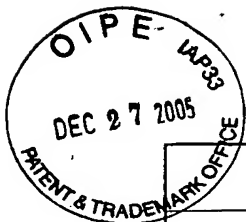
If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
	- 100 =	/50	(round up to a whole number) x	=

4. OTHER FEE(S)

	Fees Paid (\$)
Non-English Specification, \$130 fee (no small entity discount)	
Other (e.g., late filing surcharge): 2051 Surcharge-Late oath or declaration	65.00
2814 Terminal Disclaimer	65.00

SUBMITTED BY		Registration No.	31,998	Telephone	(713) 651-5462
Signature		(Attorney/Agent)			
Name (Print/Type)	John E. Schneider	Date	December 27, 2005		



AMENDMENT TRANSMITTAL LETTER

Docket No.
HO-P02901US1Application No.
10/719,795-Conf. #2945Filing Date
November 21, 2003Examiner
C. R. RichardArt Unit
1712

Applicant(s): Robert R. Wood

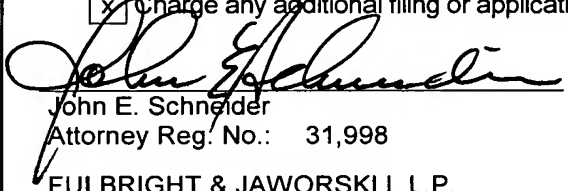
Invention: IMPROVED DRILLING FLUIDS

TO THE COMMISSIONER FOR PATENTS

Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated and is transmitted as shown below.

CLAIMS AS AMENDED					
	Claims Remaining After Amendment	Highest Number Previously Paid	Number Extra Claims Present	Rate	
Total Claims	20	- 20 =		x	
Independent Claims	3	- 3 =		x	
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					
Other fee (please specify): Supplemental Declaration Terminal Disclaimer					65.00
					65.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT:					130.00

☐ Large Entity☒ Small Entity☐ No additional fee is required for this amendment.☐ Please charge Deposit Account No. _____ in the amount of \$ _____.
A duplicate copy of this sheet is enclosed.☐ A check in the amount of \$ 130.00 to cover the filing fee is enclosed.☐ Payment by credit card. Form PTO-2038 is attached.☒ The Director is hereby authorized to charge and credit Deposit Account No. 06-2375
as described below. A duplicate copy of this sheet is enclosed.☒ Credit any overpayment.☒ Charge any additional filing or application processing fees required under 37 CFR 1.16 and 1.17.
John E. Schneider

Attorney Reg. No.: 31,998

FULBRIGHT & JAWORSKI L.L.P.

Fulbright Tower

1301 McKinney, Suite 5100

Houston, Texas 77010-3095

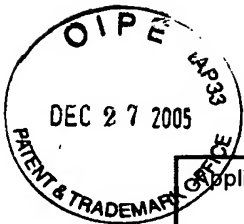
(713) 651-5462

Dated: December 27, 2005

12/30/2005 HUE333 00000066 10719795

01 FC:2051

65.00 DP



Application No. (if known): 10/719,795

Attorney Docket No.: HO-P02901US1

Certificate of Express Mailing Under 37 CFR 1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Airbill No. EV671534945US in an envelope addressed to:

MS Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on December 27, 2005
Date

Signature

Ronnie Webb

Typed or printed name of person signing Certificate

Registration Number, if applicable

(713) 651-5146
Telephone Number

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Postcard
Transmittal Form(1 page)
Fee Transmittal (1 page)
Check in the amount of \$130.00
Amendment Transmittal Letter (1 page)
Amendment (9 pages)
Exhibit A – Amendment Under 37 CFR §1.111 dated July 11, 2002 (6 pages)
Terminal Disclaimer (1 page)
Statement By Assignee to Establish Ownership (37 CFR 3.73(b)) (1 page)
Supplemental Declaration (2 pages)
Copy of Office Action dated 9/27/2005 (16 pages)



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

DEC 27 2005

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,795	11/21/2003	Robert R. Wood	HO-P02901US1	2945

26271 7590 09/27/2005
FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER

RICHARD, CHARLES R

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

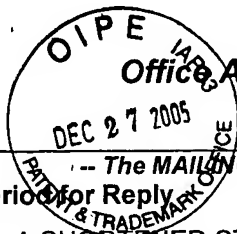
RECEIVED

SEP 30 2005

Docket: P02901US1

Client: NER INT

Attorney: SES



Office Action Summary

Application No.

10/719,795

Applicant(s)

WOOD, ROBERT R.

Examiner

C. R. Richard

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/27&9/17/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Applicant has commented in the IDS filed February 27, 2004 that priority was being claimed under 35 USC 120 to application 09/767,362. The Examiner has not been able to find any other evidence of such a claim; there is no such indication on any transmittal form, in the oath/declaration, in the PTO's PALM system, in the ADS or in the specification. In fact, under the heading "CROSS-REFERENCE TO RELATED APPLICATIONS" in the specification, Applicant has written "Not applicable." It is also of note that 09/767,362 is an application not owned by Applicant and is to an invention in the computer related art; perhaps Applicant meant 09/767,352.

Under the circumstances, the Examiner will assume that Applicant has abandoned any priority claims relating to the present case. If this is not the case, then Applicant may wish to review applicable procedures and make petition accordingly if that avenue is still available.

Information Disclosure Statement

2. The information disclosure statement filed February 27, 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language – specifically patent SU 1,121,396. This reference has

Art Unit: 1712

been placed in the application file, but the information referred to therein has not been considered.

3. The information disclosure statement filed February 27, 2004 also fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed – specifically the Kirk-Othmer reference. No copy is in the file, so the information referred to therein has not been considered.

Oath/Declaration

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective, because it does not identify the citizenship of each inventor.

Specification

5. The disclosure is objected to because of the following informalities. Paragraph 18 is incomplete – apparently Applicant forgot to delete it before filing. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims requires an expansion to at least 40% of an original size - which is a contraction. For examination on the merits, it will be assumed that Applicant meant an expansion of at least 40% of the original size instead.

8. Claim 8 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph. The claim contains more than one sentence. For examination on the merits, the Examiner will consider the limitations in both sentences.

9. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim depends from itself. For examination on the merits, the Examiner will assume that Applicant meant to make claim 9 depend from claim 7.

Art Unit: 1712

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Knapp in US Patent 3,901,316. Knapp discloses a process (and corresponding composition) for decreasing permeability in a subterranean formation (see column 1, lines 4-6).

Knapp discloses injecting an oil-in-water emulsion containing asphalt in the oil phase into a permeable formation (see column 1, lines 55-60) that may be followed by a step of selective perforation (see column 1, lines 10-25). An oil solvent such as diesel may be included (see column 3, lines 48-57). Rubber particles among others may be suspended in the emulsion with particle sizes ranging from less than about 10 to more than about 2000 microns (see column 4, lines 30-40). A cellulose ether (a form of cellulose fiber) may be used as a suspending agent (see column 4, lines 40-45). Crumb rubber is one particularly suitable particle (see column 4, lines 52-54), and is

Art Unit: 1712

commercially available in sizes ranging from 100 microns or less to over 4000 microns (see column 4, lines 54-56). A manipulation of pH is used in placing the material in the right place in the formation, as well as used in determining how far into the formation the plugging goes (see column 2, lines 15-50). Of course, the composition described by Knapp is suitable for use as a drilling fluid additive, especially one for reducing lost circulation.

The density range of claims 3 and 8, and the expansion limitation of claims 6 and 9 are inherent in crumb rubber, especially of the commercial type described (see column 4, lines 59-60). This rubber would of course expand upon heating to some extent as required in claim 7. Applicant has basically admitted all this in paragraphs 30 and 33 of the specification.

The preparing and injecting steps of claims 10-13 are explicitly given in the reference as seen above. The composition as a pill (at least effectively) is implied in the disclosures mentioned above, and the forcing step is implied/inherent in what is described above.

12. Claims 1, 3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Brothers et al. in US Patent 5,779,787. Brothers discloses a well cement with rubber particles. The rubber is preferably derived from recycled tires and is in the 10/20 to 20/30 mesh range; this rubber is commercially available (see column 3, lines 39-44). As a point of reference, 10 mesh is 2000 microns, 18 mesh is 1000 microns and 48 mesh is 425 microns (see paragraph 28 of the specification). The density and expansion

Art Unit: 1712

limitations of claims 3 and 6 are inherent in this type of rubber. Of course, this cement could be used as a drilling fluid additive.

13. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood in US Patent Application Publication 2002/0010100 (the publication of the application that later issued as US Patent 6,518,224). Note that it appears that this publication is by the same inventor as the present application, but since no proper claim to priority was made, the cited publication is available against the present application.

Wood describes a drilling fluid additive for fluid loss prevention containing crumb rubber of particle size 1 to 400 microns; this rubber can expand to 140% of its original size in a hydrocarbon, and even further when heated (see paragraphs 24-27). The density of the particles is 8.5 to 10.5 ppg (see paragraph 30). Various hydrocarbons may be used in the additive such as diesel oil (as well as all the others named in rejected claims 4 and 12) (see paragraph 31). Various cellulose fiber containing materials may be added (see paragraph 34).

The steps of claims 10-13 are given in paragraph 33.

14. Claims 1, 3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Benko et al. in US Patent Application Publication 2002/0091167 (the parent of this application has issued as US Patent 6,380,269 and has similar disclosure). Note that in the event that Applicant obtains priority to earlier filed applications in the present case,

Art Unit: 1712

the cited reference here may still be available under 102(e) and such a rejection is hereby made here in the alternative.

Benko discloses a crumb rubber within the range of 325 mesh (44 microns) to 20 mesh (840 microns) – a preferred upper limit is 40 mesh (420 microns) (see paragraph 19). The density and expansion limitations of claims 3 and 6 are inherent in this type of rubber. The material can of course be used as a drilling fluid additive.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 1-2, 4-5, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knapp in US Patent 3,901,316 especially in view of Delhommer et al.

Art Unit: 1712

in US Patent 4,633,950 and Sheeler in US Patent 2,894,906. Knapp has been discussed in detail above. Delhommer and Sheeler disclose methods and compositions for lost circulation control.

Knapp discloses all the limitation of the rejected claims explicitly or implicitly. It does not explicitly disclose all the various hydrocarbons of claims 4 and 12, but does disclose the use of oil solvents with diesel as a specific example as seen above. It would have been obvious to one of ordinary skill in the art to employ any of the other hydrocarbons of claims 4 and 12 in place of diesel, especially crude oil, mineral oil, gasoline, naphtha or kerosene (crude oil and major cuts of crude oil) from the teachings cited from Knapp. This substitution (and others) is especially obvious in view of the teachings of Delhommer; in a similar context, Delhommer teaches that the lost circulation effect becomes active when the rubber particles come into contact with a hydrocarbon such as crude oil, diesel oil, kerosene, mineral oil, gasoline, naphtha, toluene, ethylene dichloride and mixtures thereof (see Delhommer at column 5, lines 30-35 and column 6, lines 20-35).

Further, as seen above, Knapp teaches the use of a type of cellulose fiber in the context of claim 5. It would have been obvious to one of ordinary skill in the art to employ cellulose fibers in this context from this teaching. This would have been especially obvious in view of Sheeler in US Patent 2,894,906 where rubber particles are made to adhere to fibers such as cotton (basically cellulose) for use in fluid loss prevention (see Sheeler at column 3, lines 25-45).

Art Unit: 1712

17. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood in US 2002/0010100 especially in view of Knapp in US 3,901,316. Wood and Knapp have been discussed in detail above. Wood meets all the limitations of the rejected claims in the proper context as seen above, but does not teach the full range of particle sizes claimed.

Wood teaches that crumb rubber is generally 3/8 inch or less in size (8000 microns or less), and says that in the practice of the invention there that the crumb rubber should (not must) have a size of 1 to 400 microns (see paragraph 25 of Wood). It would be have been obvious to one of ordinary skill in the art to employ crumb rubber particles in the context of Wood of sizes somewhat larger than 400 microns (and somewhere below 8000 microns) from this teaching. Note that "a *prima facie* case of obviousness exists where the claimed ranges and the prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties" (see MPEP 2144.05). Wood teaches a preferred range of 20 to 400 microns at paragraph 25, negating any inference that one would notice any significant difference if one used particles at any size over 400 microns. Seemingly, 425 microns (one size suggested by the specification at paragraph 28) would be in the "obvious" range.

In a similar context, Knapp teaches the use of particles of up to 2000 and even 4000 microns (see above). From this and the above discussion on Wood, it would have been obvious for one of ordinary skill in the art to use rubber particles in the context of Wood in sizes up to 2000 and up to 4000 microns.

Art Unit: 1712

Double Patenting

18. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

19. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,518,224. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1,1,2,2,3,4,5,6,7,8,9,10,11,12,13 and 14 of US 6,518,224 recite compositions or methods within the scope of rejected claims 1,2,1,2,3,4,5,4,6,7,8,9,10,11,12 and 13, respectively, rendering the rejected claims at least obvious.

Conclusion

Art Unit: 1712


20. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. US 2,342,588; 2,743,223; 3,158,210; 6,806,232 and 2004/0244978 teach methods and/or compositions at least similar to the present invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. R. Richard whose telephone number is 571-272-8502. The examiner can normally be reached on M-Th, 8am-6pm and alternate Fridays, 8am to 5pm.

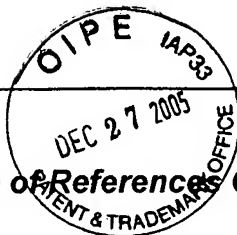
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

C.R. Richard


PHILIP TUCKER
PRIMARY EXAMINER
ART UNIT 1712

Notice of References Cited



Application/Control No.

10/719,795

Applicant(s)/Patent Under

Reexamination

WOOD, ROBERT R.

Examiner

C. R. Richard

Art Unit

1712

Page 1 of 1

U.S. PATENT DOCUMENTS

* *		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-3,901,316	08-1975	Knapp, Randolph H.	166/294
	B	US-6,518,224	02-2003	Wood, Robert R.	507/118
	C	US-6,380,269	04-2002	Benko et al.	521/41
	D	US-3,158,210	11-1964	SMITH FLOYD A; et. al.	175/72
	E	US-6,806,232	10-2004	Cart, Steve	507/118
	F	US-2004/0244978	12-2004	Shaarpour, Mano	166/293
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

* *		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

* *		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



PTO/SB/08A (10-01)

Approved for use through 10/31/2002. OMB 0851-0031

U. S. Patent and Trademark Office: U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)			Complete If Known		
			Application Number	10/719,795	
			Filing Date	November 21, 2003	
			First Named Inventor	Robert R. Wood	
			Art Unit	N/A	
			Examiner Name	Not Yet Assigned	
Sheet	1	of	1	Attorney Docket Number	HO-P02901US1

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
CNN	AA	US-2,342,588	05-08-1940	Larkin, J. F.	Col. 1, Ins. 40-43
CNN	AB	US-3,254,064	05-31-1966	Nevins, M. J.	
CNN	AC	US-3,788,405	01-29-1978	Taylor, J. B.	Table 1
CNN	AD	US-3,785,438	01-15-1978	Jackson, et al.	Claim 1
CNN	AE	US-4,510,998	04-16-1985	Peiffer	Col. 5, Ins. 38-63
CNN	AF	US-4,633,950	01-06-1987	Delhommer, et al.	Col. 1, In. 57
CNN	AG	US-4,704,213	11-03-1987	Delhommer, et al.	Col. 2, In. 64
CNN	AH	US-5,779,787	07-14-1998	Brothers, et al.	Col. 3, Ins. 40-43
CNN	AI	US-6,017,854	01-25-2000	Van Slyke	Col. 6, In. 55 to Col. 7, In. 25
CNN	AJ	US-2,743,233	04-24-1956	Fisher, H. B.	Col. 5, samples 23-26
CNN	AK	US-4,360,620	11-23-1982	Lindner, et al.	Claim 1
CNN	AL	US-5,238,977	08-24-1993	Piejko, et al.	Abstract
CNN	AM	US-2,894,906	07-14-1959	Sheeler	

FOREIGN PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Country Code ² -Number ³ -Kind Code ⁴ (if known)			
	BA	SU-1,121,396	10/1984		

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

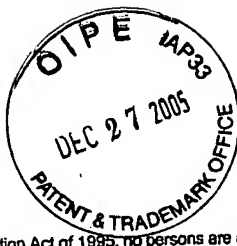
¹ Applicant's unique citation designation number (optional). ² See attached Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the application number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 18 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	CA	Kirk-Othmer, Encyclopedia of Chemical Technology, Vol. 7, 2nd Edition, Pages 297-299, 1965.	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature	Charles H. Richard	Date Considered	9/19/05
--------------------	--------------------	-----------------	---------



PTO/SB/08A (10-01)

Approved for use through 10/31/2002. OMB 0851-0031

U. S. Patent and Trademark Office: U. S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		Complete If Known			
		Application Number	10/719,795		
		Filing Date	November 21, 2003		
		First Named Inventor	Robert R. Wood		
		Art Unit	1712		
		Examiner Name	Not Yet Assigned		
Sheet	1	of	1	Attorney Docket Number	HO-P02901US1

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
CM	AA	US-2002/0010100-A1	01-24-2002	Wood	
CM	AB	US-2002/0091167-A1	07-11-2002	Benko, David Andrew, et al.	
CM	AC	US-2,894,906	07-14-1959	Sheeler, James E. R.	
CM	AD	US-2,743,233	04-24-1956	Fisher, Henry B.	

AD		US-2,143,233		1942		
FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)				

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² See attached Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the application number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature	Charles R. Richard	Date Considered	9/19/05
-----------------------	--------------------	--------------------	---------

25454599.1